Serial No.: 10/791,668
Art Unit 2821
Examiner: Phan

REMARKS

Remarks

Reconsideration of the rejection of the present Application under 35 USC 102 is hereby requested.

Claims 19 – 36 stand allowed. Claims 38 and 40-43 stand allowable.

Independent Claim 37 and dependent claim 39 stand rejected under 35 USC 102(e) as being anticipated by the newly cited reference to Hamada et al. (5,933,791), and that dependent claims 38 and 40 – 43 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Examiner states that Hamada et al. teach a nanotube bandgap device having a substrate with an ordered array of nanotubes thereon, the nanotubes having a predetermined position on the substrate, the nanotubes having a predetermined dimension (col. 2, lines 1-7); and wherein the band gap device is responsive to lightwaves (col. 11, lines 20 - 33).

Applicant respectfully disagrees that predetermined position and predetermined dimension is taught by Hamada et al.. The Hamada et al. reference makes no mention or showing of a "predetermined position" on a substrate, nor a "predetermined dimension" of a nanotube, as recited in

REMARKS

Applicant's independent claim 37. Also, the Hamada et al. reference makes no mention or showing of a substrate itself, which is recited and thus required in Applicant's independent claim 37. Note for example, that Applicant Crowley's present application teaches about both the positioning of an ordered array of carbon nanotubes on a substrate and about controlling dimensions of a nanotube on that substrate, neither of which are shown or taught by the Hamada et al. reference.

Withdrawal of the rejection of independent claim 37 is thus earnestly solicited. Additionally, since independent claim 37 is deemed allowable, dependent claim 39, as well as the remainder of the dependent claims depending upon allowable independent claim 37 are also believed allowable. A dependent claim, dependent upon an allowable independent claim is itself allowable. Such action for their allowance is thus also earnestly solicited.

To receive patent protection, an invention must be novel, i.e., not anticipated by the prior art, as under 35 USC 102. An invention is anticipated, and therefore invalid, if a single prior art reference expressly or inherently discloses each and every limitation of the claimed invention, See

Serial No.: 10/791,668
Art Unit 2821
Examiner: Phan

REMARKS

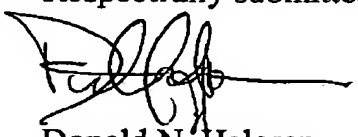
Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F2d 1565 18 U.S. P.Q. 2d (BNA) 1896 (Fed. Cir. 1991).

Clearly neither the cited prior art '791 reference, nor any other reference shows every limitation, either expressly or inherently, of the independent claim 37. Passage to allowance is therefore again requested.

Note that independent claim 32 has been amended to correct a minor typographical error. Approval is requested.

Should the Examiner believe that any issue remains unresolved, the Examiner is invited to call the undersigned for a discussion of same.

Respectfully submitted,



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